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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,228	03/29/2001	Takashi Tsue	2091-0236P-SP	2183

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,228

Applicant(s)

TSUE, TAKASHI

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/22/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 9/22/2004, to the original application filed 3/29/2001. The instant application claims a foreign priority date of 3/29/2000.
2. The rejection of claims 1-14 under 35 U.S.C. 101 as directed to non-statutory subject matter has been withdrawn as necessitated by amendment.
3. Claims 1-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle and Manolis.
4. Claims 1-22 pending. Claims 19-22 have been added. Claims 1, 6, 11, 13, 15, 17, 19, 21 are independent claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle et al. (hereinafter Mayle), U.S. Patent No. 6,542,936 issued April 2003, in view of Manolis et al. (hereinafter Manolis), U.S. Patent No. 6,583,799 issued June 2003.

In regard to independent claim 1, Mayle teaches a method of creating an image display (i.e. a customized electronic postcard) (Mayle Abstract, column 2 lines 35-51). Mayle's customization process is a series of input screens associated with clickable tabs, said screens can be interpreted as a series (plurality) of templates, because each screen is specifically tailored to input and produce a piece of a final structured result

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(intermediate results are also displayed as a postcard is built) (Mayle column 8 lines 21-42, 60-67, Figures 6-17). In addition, a user can choose an image (i.e. a user image – “andrew2.gif”) for insertion, accordingly (Mayle Figure 9-10). It is noted that no particular tab order is specified, therefore when a photo is inserted (Figure 11 – after insertion, or at beginning), said photo is essentially inserted in all of the templates (including the final result) (compare with claim 1 *“A template displaying method comprising the steps of: reading a user image and a plurality of templates each having an image insertion area for inserting the user image therein; inserting the user image in the image insertion area of each of the templates...”*).

Mayle teaches embodiments comprising the display of a “Baby Journal” and a “Family Album”, which are forms of catalogs, typically comprising user images (Mayle column 13 lines 50 to column 14 lines 12). Mayle does not specifically teach displaying the templates within said catalog. However, Manolis teaches uploading image data forming a catalog of images displayed to a user (Manolis Abstract, Figures 8-9; compare with claim 1 *“... and generating a catalog of the templates”, and “displaying the catalog.”*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Manolis’s display of user images to Mayle, so that each of Mayle’s templates (with user image) can be displayed concurrently to a user for more concise inspection and customization, resulting in a more complete baby journal/family album.

In regard to dependent claims 2, 3, 4, Mayle does not specifically teach lower resolution images and templates. However, Manolis teaches thumbnail generation (lower resolution) in association with a catalog display (Manolis column 7 lines 4-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Manolis’s low resolution method to Mayle’s images and template images, providing Mayle the benefit of thumbnail representations for a more complete catalog picture.

In regard to dependent claim 5, Mayle teaches various images available for choosing (as explained above) (see Mayle Figure 10).

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In regard to independent claim 6, claim 6 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claims 7, 8, 9, 10, claims 7, 8, 9, 10 incorporate substantially similar subject matter as claimed in claims 2, 3, 4, 5, and are rejected along the same rationale.

In regard to independent claim 11, claim 11 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 12, Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to independent claim 13, claim 13 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claim 14, Mayle teaches a plurality of user images available for use (Mayle Figure 10). Mayle also teaches using a new template (Mayle Figure 17 items 1703a, 1703b).

In regard to independent claim 15, claim 15 reflects the computer readable medium comprising computer readable instructions used for performing the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 16, Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to independent claim 17, claim 17 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claim 18, Mayle teaches a plurality of user images available for use (Mayle Figure 10). Mayle also teaches using a new template (Mayle Figure 17 items 1703a, 1703b).

In regard to claims 19-20, claims 19-20 reflect the apparatus comprising computer executable instructions for performing the methods as claimed in claims 6, 10 respectively, and in further view of the following, are rejected under the same rationale.

Mayle teaches its invention implemented using a server (Mayle column 2 lines 35-38).

In regard to claims 21-22, claims 21-22 reflect the apparatus comprising computer executable instructions for performing the methods as claimed in claims 6, 10 respectively, and in further view of the following, are rejected under the same rationale.

Mayle teaches its invention implemented using a server (Mayle column 2 lines 35-38).

Response to Arguments

7. Applicant's arguments filed 9/22/2004 have been fully and carefully considered, but they are not persuasive.

Applicant argues on pages 11 and 12 of the amendment that the cited references do not teach Applicant's claimed invention. In particular, Applicant asserts (on page 12) that Mayle does not teach "a plurality of templates" that are displayed on a catalog. It is respectfully noted that Mayle teaches a step by step method of creating a customized electronic postcard. Since each creation step (i.e. photo, caption, message, from, to, etc.) is user implemented via optional non-sequential tabs, each customization step of said postcard results in the use of a new template (i.e. a new combination of features). Since each tab is independent, the insertion of a photo (via "Photo" tab – Mayle Figure 11) propagates to each further customization point. Alternatively, a user can also create multiple postcards with the same inserted photo, each said postcard incorporating a different set of features (i.e. with caption, without caption, etc.). Mayle additionally teaches a catalog album of images. Although Mayle teaches display of each template in sequential order, what Mayle lacks is a teaching that shows each postcard image (at each creation step) displayed in catalog form (i.e. each intermediate step shown in its own display area). Monalis teaches uploading images to a server, resulting in display of each image in its own area (a catalog). The examiner applies this teaching to Mayle, providing Mayle a way to display either each intermediate postcard creation step (i.e. each template), or each completed postcard, in a displayed catalog view. Both references deal with uploading and customization of photo images, and both deal with catalogs.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this

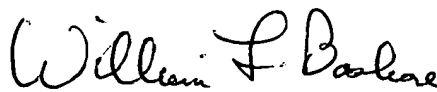
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final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM L. BASHORE
PATENT EXAMINER
TECH CENTER 2100

January 5, 2005